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EXAMINER

WHITMORE, STACY

ART UNIT

PAPER NUMBER

2812

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,674

Applicant(s)

ROBERTSON ET AL.

Examiner

Stacy A Whitmore

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

FINAL ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The prior rejections of record for claims 1-5, 7-17, and 19-22 are respectfully maintained.
3. Examiner notes that both information disclosure sheets (IDSs) numbered 7 and 9, respectively, and dated 11/4/02 and 6/18/02, respectively, have only one sheet per IDS as indicated by the "sheet 1 of 1" on both IDSs.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 7, 10, 14-16, and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Schindler, P. et al., "IP repository, a web based IP reuse infrastructure".
5. As for claims 1 and 14, Schindler taught the invention as claimed, including a method and system for selecting electronic components from a remote database over a distributed electronic network [pg. 57, abstract], comprising the steps of:
storing a plurality of dynamic parts in a remote parts database, each said dynamic parts representing an individual electronic component and is associated with a

Art Unit: 2812

plurality of component data items; [pg. 415, abstract, Introduction, and System requirements sections; IP meta data and IP data];

a server for connecting a user computer to said remote parts database [pg. 416 System overview section; and right hand side; especially “The IP vault server will distribute the IP data via a defined protocol to the IP consumer.”; and fig.’s 2-3]; and

embedding a dynamic part from said remote parts database into an application running on the user’s computer [pg. 415, especially right hand side, “IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing”].

6. As for claims 2 and 15, Schindler taught said application running on the user’s computer comprises a software program for modeling an electronic design [see as cited in the rejection of claim 1; and pg. 415, especially right hand side, “IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing”].

7. As for claims 3 and 16, Schindler taught said dynamic part functions within said application as a component of a modeled electronic design [see as cited in the rejection of claim 1; and pg. 415, especially right hand side, “IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing”].

8. As for claims 7 and 19, Schindler taught copying said component data items into a local database connected to said user computer upon embedding said dynamic part into the application [pg. 416, System overview section, “To download the IP data the user initiates the download via the web browser.” The user downloads the IP data and therefore stores the IP data on the users machine in a local database].

9. As for claim 10, Schindler taught updating said local database from said remote parts database by moving data from said remote parts database to said local database

Art Unit: 2812

in response to a user request for said data [pg. 416, System overview section, "To download the IP data the user initiates the download via the web browser." The user downloads the IP data and therefore stores the IP data on the users machine in a local database].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-5, 11-12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler, P. et al., "IP repository, a web based IP reuse infrastructure". In view of Moretti, "Got IP".

11. As for claim 4 and 17, as applied to claim 1 above, Schindler taught the invention substantially as claimed, including the method for selecting electronic components also including receiving a selection indication of a dynamic part from the user as cited in the rejection of claim 1 above.

Schindler did not specifically teach displaying said dynamic parts graphically on the user's computer.

Art Unit: 2812

Moretti disclosed displaying said dynamic parts graphically on the user's computer [pg. 33, middle column – graphics symbol].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schindler and Moretti because displaying the dynamic parts graphically on the user's computer would facilitate a higher level system development environment which would make use easier for the designer [see Moretti, pg. 33, middle column].

12. As for claim 5, as applied to claims 1 and 4 above, Schindler taught the invention substantially as claimed, including the method for selecting electronic components from a remote database over a distributed electronic network and embedding a dynamic part from said remote parts database into an application running on the user's compute [see as cited in the rejections of claims 1-4].

Schindler did not specifically teach said selection indication is performed by the user placing a graphical icon representing the selected dynamic part into said application.

Moretti taught that the displaying and receiving the dynamic parts graphically on the user's computer [pg. 33, middle column – graphics symbol].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schindler and Moretti because displaying and receiving the dynamic parts graphically on the user's computer would facilitate a higher level system development environment which would make use easier for the designer [see Moretti, pg. 33, middle column].

13. As for claims 11 and 12, Schindler taught the invention substantially as claimed, including selecting electronic components as cited above in the rejection of claim 1 above.

Art Unit: 2812

Schindler did not specifically teach said embedded dynamic part comprises a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part.

Moretti taught the electronic part comprises a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part [pg. 33, middle column – second full paragraph, the retrieval information].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schindler and Moretti because providing a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part would facilitate further information about the part and its source which would aid the design process [see Moretti, pg. 33, middle column].

14. Claims 8-9 13, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler, P. et al., "IP repository, a web based IP reuse infrastructure" in view of Walker et al. (5,862,223) (hereinafter referred to as Walker).

15. Walker was cited in the IDS dated May15, 2000.

16. As for claims 8, 9,13, and 20-22 as applied to claims 1, 7, 14, and 19, Schindler taught the invention substantially as claimed, including a method for selecting electronic components from a remote database over a distributed electronic network and embedding a set of dynamic parts into an application running on the user's computer [see as cited in the rejections of claims 1 and 7] .

Art Unit: 2812

As for claim 9, Walker taught updating said local database from said remote parts database by moving data from said remote parts database to said local database without user intervention [fig. 5, and col. 16, lines 32-44].

Schindler did not specifically teach said local database comprises a resource planning database, said method further comprising steps of entering a component represented by said dynamic part into a parts approval process, and comparing the component with data records of components already stored in said resource planning database.

Walker taught said local database comprises a resource planning database, said method further comprising steps of entering a component represented by said dynamic part into a parts approval process, and comparing the component with data records of components already stored in said resource planning database [see fig. 2, col. 14, lines 14-67, col. 17, and col. 20]. [Note that examiner interprets Walker's database information as reading on the claimed dynamic parts information because the intellectual property associated with the dynamic parts of Schindler is merely user definable information stored in a database such as that disclosed by Walker].

Schindler did not specifically teach generating an electronic bill of materials (BOM) based on said dynamic parts in said application, said BOM comprising a link to either said remote parts database or another remote database for each dynamic part.

Walker taught generating an electronic bill of materials (BOM) based on said [user selection] which comprises a link to either a remote or other database [see as cited in the rejection of claim 9 and also 14, lines 20, 45 and lines 61-65]. Walker's database information would apply to the dynamic parts of Schindler because the intellectual property associated with the dynamic parts of Schindler is merely user definable information stored in a database such as that disclosed by Walker [see Walker as cited in the rejection of claims 8].

Art Unit: 2812

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include - the generating an electronic bill of materials (BOM) based on said dynamic parts in said application, said BOM comprising a link to either said remote parts database or another remote database for each dynamic part – because the BOM of dynamic parts would enhance the design process and streamline the commerce between user and provider of the intellectual property.

17. Claims 23-25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler, P. et al., "IP repository, a web based IP reuse infrastructure" in view of Rostoker (US Patent 6,470,482).

18. As for claim 23, Schindler disclosed the invention substantially as claimed, including a computer program product that includes a computer-usable medium having a sequence of instructions which, when executed by a processor, cause said processor to execute a process for selecting electronic components from a remote database over a distributed electronic network, the process comprising:

storing a plurality of dynamic parts in a remote database, wherein each of said dynamic parts represents an individual electronic component and is associated with a plurality of component data items and modeling behavior characteristics [pg. 415, abstract, Introduction, and System requirements sections; IP meta data and IP data];

connecting a user computer to said remote parts database [pg. 416 System overview section; and right hand side; especially "The IP vault server will distribute the IP data via a defined protocol to the IP consumer."; and fig.'s 2-3]; and

embedding a dynamic part from said remote parts database into an application running on the user's computer [pg. 415, especially right hand side, "IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing"].

Art Unit: 2812

19. As for claims 24, 25, and 27, Schindler further disclosed said application running on the user's computer comprises a software program for modeling an electronic design [see as cited in the rejection of claim 1; and pg. 415, especially right hand side, "IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing"]; said dynamic part functions within said application as a component of a modeled electronic design [see as cited in the rejection of claim 1; and pg. 415, especially right hand side, "IP data should be downloaded directly by the IP consumer and made available in the target design system for SoC integration and post processing"]; and copying said component data items into a local database connected to said user computer upon embedding said dynamic part into the application [pg. 416, System overview section, "To download the IP data the user initiates the download via the web browser." The user downloads the IP data and therefore stores the IP data on the users machine in a local database].

Schindler did not specifically disclose dynamic parts associated with modeling behavior characteristics.

Rostoker disclosed dynamic parts associated with modeling behavior characteristics [abstract, ; col. 4, lines 15-52; fig. 12, behavioral description, predesigned blocks, and sim; fig. 21b, "Core elements"].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to associated the Schindler's dynamic parts with modeling behavior characteristics because including modeling behavior characteristics associated with dynamic parts would have improved Schindler's system by allowing for improved simulation of complex parts by reducing computing time to simulate function of complex parts, which would improve the overall circuit design process by reducing design time [Rostoker, col. 4].

Art Unit: 2812

20. Claims 26, and 28-29, as applied to claim 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler, P. et al., "IP repository, a web based IP reuse infrastructure" in view of Rostoker (US Patent 6,470,482), and further in view of Moretti, "Got IP".

21. As for claim 26, Schindler in view of Rostoker disclosed the invention substantially as claimed, including receiving a selection indication of a dynamic part from the user [pg. 415, IP consumer].

Schindler in view of Rostoker did not specifically teach displaying said dynamic parts graphically on the user's computer.

Moretti disclosed displaying said dynamic parts graphically on the user's computer [pg. 33, middle column – graphics symbol].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schindler in view of Rostoker, and Moretti because displaying the dynamic parts graphically on the user's computer would facilitate a higher level system development environment which would make use easier for the designer [see Moretti, pg. 33, middle column].

22. As for claims 28-29 Schindler in view of Rostoker did not specifically teach said embedded dynamic part comprises a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part.

Moretti taught the electronic part comprises a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part [pg. 33, middle column – second full paragraph, the retrieval information].

Art Unit: 2812

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schindler in view of Rostoker, and Moretti because providing a link to associated data stored in said remote parts database of a supplier or distributor of the electronic component represented by said dynamic part would facilitate further information about the part and its source which would aid the design process [see Moretti, pg. 33, middle column].

23. Applicant's arguments filed July 7, 2003, with respect to claims 1-5, 7-17, and 19-22, have been fully considered but they are not persuasive.

24. Applicant's arguments with respect to claims 23-29 have been considered but are moot in view of the new ground(s) of rejection.

I. With respect to claims 1-5, 7-17, and 19-22, applicant argues in substance that the prior art of record, mainly Schindler, does not disclose embedding dynamic parts from a remote database through the use of a server for transmitting the dynamic parts to an application running on a user computer. Applicant also argues that dynamic parts are defined in the specification to comprise both "modeling behavior characteristics and component data".

II. With respect to claims 23-29, applicant argues in substance that Schindler did not disclose dynamic parts comprising modeling behavior.

Examiner disagrees for the following reasons:

Response to I. Schindler discloses embedding dynamic parts from a remote database through the use of a server for transmitting the dynamic parts to an application running on a user computer and comprising component data [page 415, Section "System Requirements discloses the IP data, comprising a library of dynamically maintained IP data , also fig. 1, which shows the IP libraries containing IP information

Art Unit: 2812

including component data and other data, pg. 416, figs. 2-3 show the server relationship between the user and the remote databases, pg. 417 shows further the dynamic IP data – “Due to the modular and dynamic structure of the database design maintenance effort is minimal and new IP can be uploaded very efficiently”].

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., dynamic parts is defined in the specification to comprise both “modeling behavior characteristics and component data” – dynamic parts that comprise modeling behavior is not claimed with respect to prior rejected claims 1-5, 7-17, and 19-22, and further, applicant merely claims dynamic parts associated with component data items) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Response to II. [See response to I, and further the rejection of claim 23, Rostoker shows the behavioral model characteristics associated with dynamic parts].

25. Applicant's amendment (claims 23-29) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2812

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy A Whitmore whose telephone number is (703) 305-0565. The examiner can normally be reached on Monday-Thursday, alternate Friday 6:30am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Niebling can be reached on (703) 308-3325. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Stacy A Whitmore

Patent Examiner

Art Unit 2812

A handwritten signature in black ink, appearing to read 'Stacy A. Whitmore', with a stylized, flowing script.

SAW